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ECLT BAYTOWN

281 8342911 P.03

"PATENT"

TRANSMITTAL FORM

In re application of Jo Ann H. Squier, *et al.*

Examiner: Catherine A. SIMONE

Appln. No.: 09/770,960

Group Art Unit: 1772

Filed: January 26, 2001

Confirmation No.: 7021

For: CAVITATED LABELS FOR USE
WITH COLD GLUE

Attorney Docket No.: 10247

Date: July 15, 2003

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

[X] I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703/872-9311) on July 15, 2003.

Susan Engclmann

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Susan Engclmann
(Signature of person mailing paper or fee)

Transmitted herewith is an AMENDMENT UNDER 37 C.F.R. § 1.116 in the above-identified application.

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[✓] The total fee for this AMENDMENT UNDER 37 C.F.R. § 1.116 and any extension of time is calculated to be \$0.00.

[✓] Charge \$0.00 to Deposit Account No. 05-1712.

[✓] The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or credit any overpayment, to Deposit Account No. 05-1712.

July 15, 2003

Date of Signature

Rick F. James
Attorney or Agent

Rick F. James
Registration No. 48,772

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281 8342911 P.04

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 1772
"PATENT"

UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Jo Ann H. Squier, *et al.*

Examiner: Catherine A. SIMONE

Appln. No.: 09/770,960

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RESPONSE UNDER 37 C.F.R. § 1.116

Sir:

Please consider the remarks below in response to the Action mailed May 23, 2003.

Claims 1-26 are all the claims pending in the application.

The remaining rejections are:

claims 1-8 and 10-26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,150,013 to Balaji, *et al.* ("Balaji") in view of U.S. Patent 5,897,722 to Bright ("Bright"); and

claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Balaji in view of Bright and further in view of U.S. Patent 5,223,315 to Katsura, *et al.* ("Katsura").

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Applicants respectfully request that the Examiner reconsider and withdraw these §103 rejections. Modifying Balaji's in-mold label film by providing a cold-glue adhesive thereon would change the principle of operation of Balaji's film. Most importantly, modifying Balaji's in-mold label film by providing a cold-glue adhesive thereon would render Balaji's film unsatisfactory for its intended purpose as an in-mold label.

In particular, if the proposed modification or combination of the prior art disclosure(s) would change the principle of operation of the prior art invention being modified, then the teachings of the reference(s) are not sufficient to render the claims *prima facie* obvious [*see, In re Ratti*, 123 USPQ 349 (CCPA 1959)]. Similarly, if the proposed modification to the prior art would render the prior art invention being modified unsatisfactory for its intended purpose, there can be no suggestion or motivation to make the proposed modification [*In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)]. In other words, a prior art reference may not be modified so as to destroy its teachings. Modifying Balaji's in-mold label film by reference to Bright destroys Balaji's teachings.

Balaji's labels are *in-mold labels*. An in-mold label is applied to a plastic container or substrate as the container or substrate is molded. The heat of the molding process activates the adhesive and the label becomes part of the container wall.

Because Balaji's labels are in-mold labels, they need an adhesive that is heat-activated, such as the heat-seal layer disclosed at column 2, lines 34-35 of Balaji.

If Balaji's in-mold labels were modified by providing thereon a cold-glue adhesive, they would be unsatisfactory for their intended use in an in-mold labeling application. Put simply, the modified Balaji labels wouldn't work. In-mold labels operate by heat activation. A person of ordinary skill in the art would never look to Bright in order to modify Balaji's disclosure.

In order to clarify Applicants' position, Applicants below address a specific issue raised in the final Action mailed May 23, 2003.

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At page 3 of the final Action, the Examiner states the following:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "in-mold labeling") are not recited in the rejected claim(s).

Applicants confirm that the claims do not recite "in-mold labeling." The claimed labels are not in-mold labels. The point Applicants hoped to make in their remarks reproduced at page 3, lines 3-11, of the Action is the same point made above in the first two pages of this Response: a person of ordinary skill in the art would not refer to Bright in order to modify Balaji's in-mold label film.

At page 3, lines 15-17, the Examiner states that in-mold labeling is not germane to the issue of patentability of the product itself. It is agreed that the claimed labels are not in-mold labels. It must be noted, however, that the general issue of in-mold labeling is germane to the patentability of the claimed labels insofar as the Examiner is arguing that it would have been obvious to modify Balaji, which discloses in-mold labels, by reference to Bright, which does not at all relate to in-mold labeling. Modifying Balaji's in-mold label film by reference to Bright would preclude Balaji's films from operating as an in-mold label, thereby rendering the modification improper under the rules.

Finally, at page 4, lines 6-8, of the Action, the Examiner concludes that it would have been obvious to have provided the label in Balaji with a cold-glue adhesive as suggested by Bright in order to adhere a polymeric label to a container. For all the reasons set forth herein above, and the reasons presented in the Amendment filed March 6, 2003, Applicants respectfully submit that it is actually improper to base a §103 rejection on an assertion of modifying Balaji's in-mold label film by reference to Bright.

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Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: July 15, 2003


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*** * * * OFFICIAL FILING * * * ***

RE: AMENDMENT UNDER 37 C.F.R. § 1.116

Applicant(s): Jo Ann H. Squier, et al.
 Serial No.: 09/770,960
 Filing Date: January 26, 2001
 Our Docket No.: 10247
 Examiner: Catherine A. SIMONE
 Art Unit No.: 1772
 Conf. No.: 7021
 Invention: "Cavitated Labels For Use With Cold Glue"

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